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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,860	10/30/2003	Terrence Anton	10052-001	9768
29391 7590 12/26/2007 BEUSSE WOLTER SANKS MORA & MAIRE, P. A. 390 NORTH ORANGE AVENUE SUITE 2500 ORLANDO, FL 32801			EXAMINER GRAHAM, MARK S	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 12/26/2007	DELIVERY MODE PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/697,860
Filing Date: October 30, 2003
Appellant(s): ANTON ET AL.

Cian G. O'Brien
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/9/07 appealing from the Office action
mailed 3/15/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 95/02436	Jones	1-1995
4,225,136	Beam	9-1980
5,451,000	Shaw et al.	9-1995

6,217,458	Armstrong, III et al.	4-2001
5,076,586	Taniguchi et al.	12-1991
4,413,827	Aberg	11-1983

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 39, 40, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Beam. Jones (See Fig. 1) discloses the claimed course with the exception the use of substantially equal rectangular dimensions for each hole. However, as disclosed by Beam it is known in the art to use such an arrangement to save ground area. Note Beam's Fig. 1 and Col. 4, lines 28-32. It would have been obvious to one of ordinary skill in the art to have provided Jones' holes in the same manner if it was desired to provide a more compact golf course.

Regarding the tee positioning Jones discloses that it is known to locate tees at various positions along the fairway. How the tee areas are used is not at issue.

Concerning claim 40, the examiner took official notice that golf courses are commonly provided with extra space and swimming pools in country club settings to provide various activities and such is now admitted prior art. It would have been obvious to one ordinary skill in the art to have provided Jones' course in the same manner for the same reason.

Claims 22-28, 30, 32, 33, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Beam and Shaw. Jones (Fig. 1) discloses the

claimed course with the exception the use of substantially equal rectangular dimensions for each hole. However, as disclosed by Beam it is known in the art to use such an arrangement to save ground area. Note Beam's Fig. 1 and Col. 4, lines 28-32. It would have been obvious to one of ordinary skill in the art to have provided Jones' holes in the same manner if it was desired to provide a more compact golf course.

With regard to the irrigation system, as noted previously such are known in the art as typified by Shaw. It would have been obvious to one of ordinary skill in the art to have provided such with Jones course as well to provide irrigation.

Regarding the tee positioning Jones discloses that it is known to locate tees at various positions along the fairway. How the tee areas are used is not at issue.

Claims 29 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 22 and 44 respectively above, and further in view of Taniguchi. Claims 29 and 45 are obviated for the reasons set forth in the claim 22 and 44 rejection with the exception of the lighting. However, as disclosed by Taniguchi it is known in the art to use such on golf courses. It would have been obvious to one of ordinary skill in the art to have done the same with Jones' golf course to allow for night play.

Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 22 above, and further in view of Armstrong. Claims 35-37 are obviated for the reasons set forth in the claim 22 rejection with the exception of the target. However, it is known in the golf art to use such targets for golf games as disclosed by Armstrong. It would have been obvious to one of ordinary skill in the art to

have used such on Jones' course as well to play a game such as that disclosed by Armstrong.

Claims 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 39 above, and further in view of Armstrong. Claims 35-37 are obviated for the reasons set forth in the claim 39 rejection with the exception of the target. However, it is known in the golf art to use such targets for golf games as disclosed by Armstrong. It would have been obvious to one of ordinary skill in the art to have used such on Jones' course as well to play a game such as that disclosed by Armstrong.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 40 above, and further in view of Aberg. Concerning claim 41, Jones in view of Beam does not place limits on the size of the golf course. However, the examiner took official notice that it is commonly known to provide golf courses in a shrunken form to save space and it would have been obvious to one of ordinary skill in the art to have done the same with the Jones/Beam course. In response to applicant's request for the examiner to provide evidence of the official notice taken the Aberg reference has been cited to show an example of the well known concept of a shrunken course. As asserted by the examiner it would have been obvious to one of ordinary skill in the art to have provided the Jones/Beam course in such a fashion if limited space was a consideration.

(10) Response to Argument

Appellant's entire argument is based on the alleged impropriety of the combination of Jones in view of Beam.

The first argument presented in this regard appears at the middle of page 7 of the brief, wherein appellant asserts that Jones emphasizes that his golf course must not include any hole which overlaps the terrain of any other hole. Appellant's position is that because different holes on Beam's course share different portions of a golf course feature such as a pond or a sand trap, Beam teaches away from Jones. This position is not tenable because it is not an accurate reading of the Jones teaching emphasized by the appellant. Clearly what Jones is stating with regard to overlapping terrain is that one hole on a course does not overlap with any other hole on the course. Neither Jones nor Beam teach overlapping one hole on the course with another so the teaching of either in this regard is not in contradiction with the other. As one simple example of how appellant's reading of this language of Jones fails, attention is directed at Fig. 2A of Jones where it can be seen that at least three holes, 6, 7, and 9 share a common water hazard though they do not overlap with any part of the terrain of each other.

Regarding the argument on page 8 of the brief that the examiner has not identified a reason that one of ordinary skill in the art would have been prompted to combine the references, such is plainly not the case. As set forth above, and in the numerous actions received by appellant in this application, the point of the rejection is that in a limited space situation, as discussed by Beam, a reduced size version of a golf course may be offered by providing a smaller 18 hole modular layout wherein each hole

is fitted into an identical rectangular boundary. One of ordinary skill in the art seeking to provide holes with varied teeing areas such as Jones in a limited space would obviously have seen the benefits of using a compact modular system such as taught by Beam to lay out the course. At the very least, as per *KSR International Co. v. Teleflex, Inc.*, 550 U.S. at ___, 82 USPQ2d at 1397 it would have been obvious to the ordinarily skilled artisan working in the golf course to have tried taking a space saving solution from one known golf course in the art and applied to another known golf course with the predictable result.

In response to applicant's argument on page 8, second paragraph of the brief, that there is no suggestion in Jones to combine the references, obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art, in the form of Beam, that golf courses may be constructed with a modular design as claimed would have provided motivation to apply the same teaching to other golf courses with the identifiable predictable result.

Appellant's argument that such a combination requires downsizing Jones course into portions ignores the basis of the rejection. Beam has only been cited to show that

in the golf course art it is known to provide each hole of the course as a modular identically sized rectangularly bounded hole.

Beam shows a downsized golf course. Eighteen holes in a reduced size format are presented. That Beam's holes are designed to emphasize particular parts of the golf game does not negate this fact. Jones teaches normal size holes of the design claimed by appellant. Beam teaches that when downsizing a golf course, holes may be provided within defined rectangular boundaries adjacent to one another to save space.

The examiner is not suggesting that one physically fit a full size hole such as Jones' or a part thereof within the boundaries of one of Beam's course. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The balance of applicant's arguments regarding claims 39-48 are an abbreviated repeat of the arguments presented with regard to claims 22-30, 32, 33, and 35-37. The examiner's response to these arguments remains identical to that set forth in the above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

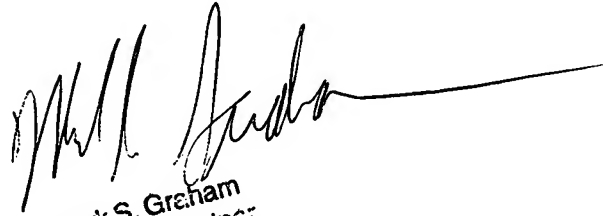
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham



Mark S. Graham
Primary Examiner

Conferees:

Eugene Kim



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SUPERVISORY PATENT EXAMINER

Xuan Thai



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